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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,450	11/12/2003	Scott William Rosencrance	09328.105084 US	7997

7590 02/13/2006

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EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/706,450	Applicant(s) ROSENCRANCE ET AL.	
	Examiner Carlos Lopez	Art Unit 1731	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation of 13. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-19, 22, 25-50, 53, 56-80.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation of 13.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☒ Other: See Continuation Sheet.

Continuation of 13. Other:

The incorporation of the HLB and/or pH values into the independent claims results in new combinations with the other remaining dependent claims that require further consideration and search. Although applicant argues that the limitations have already been examined, the incorporation of the limitations from the dependent claims 17 and 73 into the independent claims 1, 60 and 70 results in new combinations, not search or considered, when considering the remaining dependent claims.

Applicant argues that the amendment obviates the 35 USC 103 rejections because the cited references fail to disclose an HLB greater than 13 and a pH in the range from 6.0 to 8.8. In regards to the argument that the references do not teach the claimed pH, applicant is referred to the rejection of claims 17-18 in the Final Rejection mailed on 9/8/05, page 3, wherein it is noted that Cook discloses that deinking is normally carried out at an alkaline pH above 7, thus encompassing at the very least applicant claimed range of 7.0 to 8.8.

Applicant also argues that the references do not disclose an HLB of greater than 12 and would not have motivated a skilled worker to employ such surfactant in a flotation process, nor does the reference support a prima facie case of obviousness because it does not disclose low-alkaline deinking, and it would not have motivated a skilled worker to deink in low-alkaline conditions using a high HLB alkylated fatty alcohol and between 20 and 60wt% of fatty acid. A low alkaline deinking in combination with a high HLB is not a combination whose merits have been examined. As such, applicant's arguments hinges on limitations that have not been considered and searched prior to the closing of prosecution of the instant application.

Applicant also alleges that there is unexpected result in using a higher HLB surfactant because as shown in table 3 when using an HLB less than 9 results in "worse Brightness and Eric values." Regarding recycled paper, the prior art normally seeks high brightness values and low Eric values, wherein Eric values measure the retention of residual ink remaining in the recycled paper. It is noted that the sample using an HLB of less than 9, as alleged by applicant to be inferior to the claimed invention, results in a higher brightness of 50.2 and lower Eric value of 516 in contrast to the claimed invention using an HLB of greater than 13 which results in a brightness of 49.3 and Eric value of 534. Yet applicant states "This surprising result could not have been expected from the prior art, which teaches that lower HLB surfactants are needed in flotation deinking systems." Hence, based on what the prior art teaches, it appears that the only "surprising result" is the fact that applicant seeks properties that are deemed undesirable in the prior art. Applicant is invited to further explain why a lower brightness and higher Eric value provides surprising results from products used in the prior art that have an improved brightness and Eric values.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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